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| 09/839,562 | 04/20/2001 | Troy Wilford | 8932-268 | 1273 |
| 20583 | 7590 | 07/02/2004 | EXAMINER | |
| JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017 | | | ODLAND, KATHRYN P | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3743 | |

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,562

Applicant(s)

WILFORD, TROY

Examiner

Kathryn Odland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 2,4,6,16,24 and 29-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7-15,17-20 and 25-28 is/are rejected.
- 7) ☒ Claim(s) 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 24 and 29-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 12, 2004. Claims 1, 3, 5, 7, 8-15, 17-20 and 25-28 are under consideration.

Response to Amendment/RCE

This is also a response to the Amendment/RCE dated March 11, 2004.

Response to Arguments

2. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3. Claim 28 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It appears that claim 28 merely restates that stated in claim 1.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3, 5, 7-15, 20, and 25-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Papay et al in US Patent No. 6,517,542.

Regarding claim 1, Papay et al. disclose a fixation device, as seen in figure 17, for securing one end of a graft to bone. The device has an implant body (242) with first and second ends. The first end has an opening (such as via 452) configured and adapted for receiving an insertion tool and the second end has a recess (such as 150) and a graft interface member (244) having a graft holding portion and an implant coupling portion (270), at least a portion of the coupling portion is configured and adapted to be received in the recess to permit the implant body to rotate independent of the graft interface member. Further, the implant coupling portion has a snap-fit type connection and the graft holding portion has a central longitudinal axis and is configured and adapted to hold a graft aligned with the central longitudinal axis, as recited in column 4, lines 46-65.

Regarding claim 3, Papay et al. disclose that as applied to claim 1, as well as, a graft holding portion that is a cage, as seen in figures 15-19, for example.

Regarding claim 5, Papay et al. disclose that as applied to claim 3, as well as, a cage that has a cage bottom portion and a cage top portion **attachable** to the cage bottom portion, as seen in figures 15-19.

Regarding claim 7, Papay et al. disclose that as applied to claim 1, as well as, a coupling portion with a flexible post (portions of the snap-fit), as recited in column 4, lines 54-65.

Regarding claim 8, Papay et al. disclose that as applied to claim 7, as well as, a flexible post that has a flared tip portion (portion of the snap-fit), as seen in figures 17-19.

Regarding claim 9, Papay et al. disclose that as applied to claim 8, as well as, a flared tip portion that is slotted (there are slots between the snap-fit components), as seen in figures 17-19.

Regarding claim 10, Papay et al. disclose that as applied to claim 1, as well as, a recess in the second opposed end that has an undercut section, as seen in figures 17-19.

Regarding claim 11, Papay et al. disclose that as applied to claim 1, as well as, an implant body and a graft interface that are integrally connected to each other, as seen in figures 17-19.

Regarding claim 12, Papay et al. disclose that as applied to claim 5, as well as, a cage top that has at least one detent configured and adapted to attaché the cage top portion to the cage bottom portion, as seen in figures 17-19 (the snap-fit connection).

Regarding claim 13, Papay et al. disclose that as applied to claim 12, as well as, a cage bottom portion that has at least one fitting configured and adapted to receive the detent, as recited in column 4, lines 50-65 and seen in figures 17-19.

Regarding claim 14, Papay et al. disclose that as applied to claim 5, as well as, a bone cage that has at least one wall portion (such as the interior of the bore) and the at least one opening through the at least one wall portion, as seen in figures 17-19.

Regarding claim 15, Papay et al. disclose that as applied to claim 14, as well as, as well as a wall portion that has an interior surface having serrations, via the snap fit components.

Regarding claim 20, Papay et al. disclose that as applied to claim 1, as well as, an implant body that has an outer surface that at least a portion of which has thread for implantation into bone, as seen in figures 17-19.

Regarding claim 25, Papay et al. disclose that as applied to claim 1, as well as, an implant coupling portion that is received in the recess from the send end of the implant, as seen in figure 17-19.

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Regarding claim 26, Papay et al. disclose that as applied to claim 1, as well as, a graft holding portion that is a cage having at least two separate members, wherein the snap-fit connection defines at least two members and the inside bore is considered part of the cage when in engagement.

Regarding claim 27, Papay et al. disclose that as applied to claim 26, as well as, a cage having first and second members that mate, as defined by the snap-fit connection.

Regarding claim 28, Papay et al. disclose that as applied to claim 27, as well as, first and second members that snap together.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papay et al. in US Patent No. 6,517,542.

Regarding claim 17, Papay et al. disclose that as applied to claim 1. However, a first opening that is hexagonal has not been recited. On the other hand, the current application specification does not demonstrate the criticality for the hexagonal shape. Thus, any shape that provides the same function can be considered an equivalent.

Regarding claim 18, Papay et al. disclose that as applied to claim 1. However, an internally threaded implant has not been recited for the embodiment discussed. On the other hand, it is within the scope of the invention and disclosed for alternate embodiments to have internal threads.

Regarding claim 19, Papay et al., as modified, disclose that as applied to claim 17. Further, it is within the scope of the invention to have internal threads, as discussed with regard to claim 18.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KO



Henry Bennett
Supervisory Patent Examiner
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